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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/107,643 06/30/98 TRACY

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QM12/0801

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EXAMINER

MAGER, C

ART UNIT

PAPER NUMBER

3761

DATE MAILED:

08/01/00
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/107,643

Applicant(s)

TRACY, RHONDA

Examiner

Carie Mager

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on 19 May 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78). Applicant's amendment of 10/28/99 (Paper No. 14) amends the first sentence of the specification to refer to prior applications; however two of the application serial numbers are incorrect. Reference to Serial No. 516,473 and 93,681 should be corrected to 07/516,473 and 07/093,681 respectively.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Foreman (US Pat. 4,816,025).
4. With regard to claim 7, Foreman discloses a standard hourglass shape diaper (Fig. 1) having a plastic outer layer (col. 8, lines 43-47) and a liquid absorbent layer (col. 7, lines 41-56). Foreman also discloses a soft padding member (see element 262 shown in Fig. 3 and col. 5:56-58) located along at least one of the waistband portions, adjacent to the outer layer edge (*the*

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plastic layer edge); the soft padding member being distinct from the body portion layer, the soft padding member being located between the diaper wearer and the plastic layer edge when being worn by the wearer.

5. With regard to claim 8, Foreman discloses a standard hourglass shape diaper (Fig. 1) having a plastic outer layer (col. 8, lines 43-47) and a liquid absorbent layer (col. 7, lines 41-56). Foreman also discloses a strip of non-abrasive material (see element 262 shown in Fig. 3 and col. 5:56-58) located along at least one of the waistband portions, substantially adjacent to the outer layer edge (*the plastic layer edge*); the strip being distinct from the body portion layer, the strip providing a cushion between the diaper wearer and the outer layer (*plastic layer*) edge when being worn by the wearer.

6. To the extent that applicant may argue that the cuff of Foreman is not a “soft padding member” the following rejection is additionally being made.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foreman in view of Lindquist (US Pat. 3,572,342).

9. Foreman discloses the invention as claimed except for the express provision of a “padding member.”

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10. Lindquist teaches in the same field of endeavor to provide padding elements '37 and '38 made of foam applied along the portion of the diaper at which seepage of fluids is not desired along the upper surface of a diaper.

11. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the upper surface of end cuffs 262 of Foreman with padding elements made of foam in order to retard fluid. (See 1:15-20)

12. Claims 7-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McConnell et al (3,461,872).

13. McConnell discloses a diaper retaining garment (Fig. 1) including an absorbent pad (26 and 27) (Figs. 5 & 6). The body includes two enlarged end portions, a narrowed intermediate portion, a waist band portion at each end (see the end portions), at least two body portion layers including a layer of liquid absorbent material (26 & 27) and a plastic layer having an edge at the edge of the diaper (the body portion 10 of a flexible polymeric cellular material, an opened celled foam such as polyurethane is a plastic layer and the elastic strip 21 is also considered to be a plastic material) and a soft padding member (which is also a non abrasive strip, see element 22 in figures) located along at least one of the waistband portions adjacent the plastic edge, so that the soft (non-abrasive) substance is located between the diaper wearer and the plastic layer edge, such that the diaper presents a soft (non-abrasive) surface at the waistband portion despite the plastic edge.

14. McConnell discloses:

1. The elasticized edges 11, 12, 18 and 19, are preferably covered by fabric outer strip 22 to prevent contact of the wearer with the elastic material forming strip 1. This strip 22 is sewn on along with the elasticized strip 21 and forms an envelope around it. The details of this construction feature can clearly be seen from Figure

2. The material forming the outer strip 22 may comprise any type of flexible material but is preferably a woven fabric or scrim.” (3:30-39)

15. The outer strip 22 wraps around the elastic (21) and the body (10), thus it inherently presents a soft surface or a non-abrasive surface at the waistband portion. According to Webster’s Dictionary “scrim” is usually a cotton fabric. Also, McConnell states the elasticized edges are covered by a fabric outer strip 22 to prevent contact of the wearer with the elastic material, thus it is inherently a soft material. If it is not inherent, that the material is soft and nonabrasive, then it would have been obvious to one of ordinary skill in the art at the time the invention was made because it is well recognized that babies skin is soft and easily irritated. Why else would McConnell cover the elastic strip with a fabric to prevent contact of the wearer with the elastic. One of ordinary skill would not cover an elastic with a hard or abrasive material as it defeats the purpose of covering it.

16. Regarding claims 9 and 10, the strip or soft padding member extends from the inside to the outside of the diaper.

17. Additionally, it is noted that applicant’s declaration states that the cotton around the waistline and leg lines of the diaper is a very fine, small layer of cotton, which would be very similar, but not exactly the same as that of a gauze pad or the inside of a gauze pad. McConnell discloses the use of a “woven fabric or scrim”, which is essentially the same thing.

Double Patenting

18. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

19. Claims 7-10 are rejected under the judicially created doctrine of double patenting over claims 1-5 of U. S. Patent No. 5064421 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

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20. Claims 7-10 are rejected under the judicially created doctrine of double patenting over claims 1-15 of U. S. Patent No. 5797824 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Response to Arguments

21. Applicant's arguments filed 4/19/00 (paper No. 19) have been fully considered but they are not persuasive.

22. Regarding the effective filing date, applicant can not swear behind a 102(b) reference. Foreman is a 201(b) reference because applicant can only rely on the filing date of the earlier filed design application (07/93,681) for what the application teaches. Since the design application does not provide support for the material along the edge of the waistband being a soft padding member and Foreman was filed more than a year before the filing date of the 07/516,473 application, it is a 102(b) reference. See *In re Chu*, 36 USPQ 2d. 1089 at 1093

(CAFC). "It is elementary patent law that a patent application is entitled to the benefit of the filing date of an earlier filed application only if the disclosure the earlier application provides support for the claims of the later application, as required by 35 U.S.C. §112." The design application does not provide support for the claimed invention, so applicant can not rely on the design application for it's filing date and thus swear behind the reference. The design application does not teach that the material along the edge of the waistband is a soft padding member distinct from the body portion layer to present a soft surface at the inside of the diaper waistband portion to the wearer or a strip of non-abrasive material located along the waistband portion to provide a cushioned surface at the inside of the diaper waistband portion to the wearer. Muchless, does the design application provide support for the material comprising a cotton material around the waistline and leg lines of the diaper that are a very fine, small layer of cotton which would be very similar, but not exact to that of a gauze pad or inside of a gauze pad.

23. The declaration filed February 2, 1999 under 37 CFR 1.131 has been considered but is ineffective to overcome the Foreman reference. The Foreman reference is a statutory bar under 35 U.S.C. 102(b) and thus cannot be overcome by an affidavit or declaration under 37 CFR 1.131.

24. Regarding the double patenting rejection, applicant may file a supplemental terminal disclaimer stating that the person has 100% or the whole interest. The will be withdrawn when a proper terminal disclaimer has been filed.

25. Regarding McConnell, the BPAI has not considered the McConnell reference as it is now being applied. If applicant contends that the current claims are the same as those found in applicant's earlier application which is now a patent, a 101 statutory rejection would then apply.

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Conclusion

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carie Mager whose telephone number is (703) 306-5716. The examiner can normally be reached on Monday-Tuesday, Wednesday-Friday 7:00-5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

CM
July 28, 2000


John G. Weiss
Supervisory Patent Examiner
Group 3700